

REMARKS/ARGUMENTS

This paper is submitted in response to the Office Action mailed September 1, 2006. A Request for a Two-Month Extension of Time under 37 CFR 1.136(a) is submitted herewith, along with the fee prescribed by 37 CFR 1.17(a)(2). The response is therefore timely. Reconsideration is respectfully requested.

Status of the Claims: Claims 27-66 are pending. Pursuant to a restriction/election requirement, claims 36-55 have been canceled as being drawn to a non-elected invention, without prejudice to Applicant's right to re-file the subject matter of these claims in a divisional application. Claims 29, 30, and 62-66 were withdrawn by the Examiner as being directed to non-elected species, subject to Applicant's right have these claims considered in this application upon the allowability of a generic or linking claim. Accordingly, only claims 27, 28, 31-35, and 56-61 have been examined on the merits, and all of the examined claim stand rejected.

In response to the Office Action, Claims 27, 31, 56, 57, and 62 have been amended; claims 60 and 63 have been canceled; and new claims 67-71 have been added. As explained below, it is respectfully submitted that claims 27, 28, 31-35, 56-59, 61, and 67-71, as amended, are allowable, and that claims 29, 30, 62, and 64-66, although previously withdrawn, should now be restored to prosecution and allowed.

Double Patenting: Claims 27 and 56 were rejected on the grounds of obviousness-type double patenting as unpatentable over claims 12-15 and 17-19 of US 6,602,261. Accordingly, a Terminal Disclaimer under 27 CFR 1.321(c) is submitted herewith, along with the fee prescribed by 37 CFR 1.20(d).

Rejections under 35 U.S.C. §§ 102(b) and 103(a): Claims 27, 28, 57, and 58 were rejected as anticipated by Zollikofer et al. ("A Combination of Stainless Steel Coil..."). Claim 56 was rejected as unpatentable over Zollikofer et al. in view of US 5,382,259 – Phelps et al. Claims 31 and 32 were rejected as unpatentable over Zollikofer et al. in view of US 5,350,397 – Palermo et al. Claims 33-35 were rejected as unpatentable over Zollikofer et al. in view of Palermo et al. and in further view of US 6,015,424 – Rosenbluth et al. Claims 59 and 61 were rejected as

unpatentable over Zollikofer et al. in view of US 5,695,480 – Evans et al. (The rejection of claim 60 is mooted by the cancellation of that claim.) The rejections are respectfully traversed.

Independent claims 27, 31, 56, and 62 have been amended to define the embolizing element of the invention as comprising a hydrophilic polymer that “expands volumetrically at a controlled rate in an aqueous environment.” Independent claim 57 has been amended to define the polymer as “exhibiting a delayed volumetric expansion when exposed to an aqueous environment.” New independent claim 68 includes the same limitation. Support for these limitations is found in the specification at page 20, lines 3-21 (Page 8, Paragraph 0099 of Patent Application Publication No. 2004/0059370).

Zollikofer et al. mentions only one type of material for the embolizing element attached to the carrier: polyvinyl alcohol. This material does not exhibit the controlled volumetric expansion or the delayed volumetric expansion described in the specification of the instant application or defined in the claims as amended herein. There is no suggestion in Zollikofer et al. or in the other art of record of any material that exhibits these qualities, nor is there any suggestion that such qualities would be needed or advantageous.

In short, none of the art of record, taken singly or in any combination that might reasonably suggest itself to those skilled in the pertinent arts, teaches or suggests the invention defined in claims 27, 31, 56, 57, 62, and 68, as set forth above. Claims 28-30, 58, 59, 61, 64-67, and 69-71 are dependent claims that include the above-discussed limitations, and therefore also define patentably over the art of record. In this regard, since there are now allowable generic or linking claims (such as claims 27, 28, 31-35, 56-59, 61, 68, and 69), it is respectfully requested that the previously withdrawn claims directed to non-elected species (claims 29, 30, 62, and 64-66) should now be restored to prosecution and allowed.

///

///

///

In summary, it is respectfully submitted that claims 27-35, 56-59, 61, 62, and 64-71 are allowable over the art of record and should be allowed. Passage of the application to issue is therefore earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'H. Klein', is written over a horizontal line.

HOWARD J. KLEIN
Registration No. 28,727

Date: January 31, 2007

Klein, O'Neill & Singh, LLP (Customer No.: 22145)
43 Corporate Park, Suite 204
Irvine, California 92606
Tel: (949) 955-1920
Fax: (949) 955 1921
E-mail: hjklein@koslaw.com

Attorney Docket No. 612-04-CIP3-CON